

REMARKS

Reconsideration of this application is respectfully requested.

In the Official Action, the Examiner rejects claim 2 and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,172,446 to Bucalo (hereinafter "Bucalo") in view of U.S. Patent No. 3,540,433 to Brockman (hereinafter "Brockman") and further in view of U.S. Patent No. 4,206,000 to Schuchardt et al., (hereinafter "Schuchardt"). Additionally, the Examiner rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Bucalo, Brockman and Schuchardt and further in view of U.S. Patent No. 4,309,782 to Paulin (hereinafter "Paulin"). The Examiner also rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Bucalo, Brockman and Schuchardt and further in view of U.S. Patent No. 4,445,235 to Slover et al., (hereinafter "Slover"). Lastly, the Examiner rejects claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Bucalo, Brockman and Schuchardt and further in view of U.S. Patent No. 6,632,175 to Marshall (hereinafter "Marshall").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Firstly, the Applicants respectfully submit that the combination of Schuchardt with either of the Bucalo and Brockman references is improper and must be withdrawn.

With regard to the combination, Applicants respectfully submit that there is no motivation to combine such references nor would those skilled in the art feel that the combination is predictable.

Bucalo and Brockman are related to the digestive system and passing something included in feces and separating that something from the feces while Schuchardt is

unrelated to bodily functions and only relates to filtering magnetic particles from a bath. That is, Schuchardt only separates magnetic particles that are suspended in a bath and not filtered from a flow or stream being excreted from a body (or from a fluid stream in general).

Thus, for at least the reasons set forth above, the Applicants respectfully submit that the rejection of at least claims 2 and 29 for obviousness under 35 U.S.C. 103(a) is improper and must be withdrawn.

Secondly, Applicants respectfully submit that at least the Schuchardt reference is from a non-analogous art and is an improper reference to be applied against at least claims 2 and 29.

To be considered analogous art, the references cited by the Examiner must be either in the same field as the invention or be reasonably pertinent to the problem faced by the inventor.¹ Applicants respectfully submit that neither of these requirements have been met in the present case.

With regard to the first prong of the non-analogous art test, namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” -in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.²

¹ See, e.g., *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

² *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the fields of the references for a solution to the problem facing the inventor.³

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.⁴

In this regard, Applicants submit that Schuchardt is neither directed to the same field of endeavor nor directed to solving the same problems as the invention recited in claim 2. Schuchardt is directed to the non-analogous field of filtering magnetic debris out of a bath and as discussed above, is not concerned with the objective of catching a moving object from a stream but for separating magnetic particles that are suspended in a bath.

To paraphrase the words of the Federal Circuit, the matter with which the Schuchardt reference deals logically would not have commended itself to the inventors' attention in considering his problem. Thus, since it is directed to different purposes, the inventors would accordingly have had no motivation or occasion to consider it.

³ Id. See also, *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) (“[A]s with all section 103 decisions, judgment must be brought to bear based on the facts of each case.”).

⁴ *In re Clay*, 23 USPQ 2d at 1060-1061.

Accordingly, Applicants respectfully submit that the Schuchardt reference is not in the same field of endeavor as the claimed invention, nor is it reasonably pertinent to the particular problem with which the inventors of the claimed invention were involved. Consequently, the Examiner is respectfully requested to withdraw the Schuchardt reference, thereby rendering the 35 U.S.C. 103(a) rejection of at least claims 2 and 29 moot.

Applicants submit that claims 10 and 31 are allowable for at least the same reasons as set forth above with regard to claims 2 and 29. Applicants further submit that claims 10 and 29 are at least allowable as depending from an allowable base claim (2 and 29, respectively).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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